

## DISCUSSION

To begin, it should be emphasized that:

nothing in Allison 6,546,230 suggests DELETING practice of the step thereof which administers a competency test, (which is at the heart of Allison 230 method), and

the ADDING OF a step which requires a user of the Allison 230 service to receive categorized information

at least twice,

where information in the category has been updated between said two receipt episodes.

Nothing in Allison 230 would lead one skilled in the art to eliminate the step of accessing a test, (that would render the Allison invention inoperable), and add a step involving repeated accessing of information. And note that it is a competency test which a user of the Allison 230 method accesses, not periodically updated information. What the practitioner of Allison 230 accesses is the competency test, and nothing suggests it be updated and accessed again! The present invention does NOT include accessing a test, but DOES REQUIRE that what is accessed, (categorized professional information), be accessed at least twice, with information having been updated between accessing episodes. In fact, Claims 1, 12, and 19 of the Present Application are exclusive of the method of Allison 230 as it is recited in said Claims 1, 12 and 19 the:

said method being further characterized in that the

information in said client identified and received audio format professional continuing education is prepared to keep said client aware and informed of developments in the topical category and thereby maintain professional currency therein, to the exclusion of being prepared to train said client to overcome a specific documented professional competency deficiency.

Further, it is noted in passing that Graham vs. John Deere Co. requires that a finding of obviousness under Section 103 must be based on a primary reference which, while not completely disclosing an entire new invention, (via Section 102), provides guidance to one skilled in the art that would lead him or her to seek out additional art, and incorporate said additional art into the primary reference in a way that results in the new invention. There must be teachings in the primary reference that would direct one skilled in the art to select elements in identified additional art, (while rejecting other elements therein), then modify said selected elements and combine them with elements in the primary reference to arrive at the new invention. It is argued that a proper application of Graham must also suggest elimination of elements in the primary reference which are not a part of the new invention, and if certain elements in a primary reference can not be eliminated while leaving the invention therein operable, then it must be concluded that nothing in the primary reference suggests their elimination. A new invention that does not include such necessary elements in a primary reference invention can not be found obvious based on the primary reference, if said necessary element can not be eliminated in the primary reference without rendering it inoperable.

In light of the above, it is noted that the Patent to Allison, No. 6,546,230, describes a method for assessing the

skills of medical professionals and involves a medical professional accessing a competency test over a network link. (Note that there is no such test in the present invention method and nothing in Allison 230 remotely suggests elimination of the competence test, as without it there would be no way to identify deficiency in a subject who practices the Allison invention method). It is the competency test that is directly accessed under Allison 230, and not audio format periodically updated professional continuing education. Pending Claims 1, 12 and 19 are mended to require that the audio format periodically updated professional continuing education be DIRECTLY accessed, as opposed to indirectly via first accessing a test, as in Allison, in practice of the present invention to make this distinguishing factor clear. It is noted that here DIRECTLY Accessing means that no intermediate qualifying steps are required. To make this clear in what is Claimed, the last paragraphs in Claims 1, 12 and 19 are amended to read:

said at least one paying client accessing, without requirement of intermediate steps, and receiving audio format professional continuing education information in said topical category while optionally tending to other tasks not requiring of listening;

Continuing, based on the results of the directly accessed competence test in Allison a medical professional is provided a list of courses over the network link which might or might not be available over the network and which a practitioner of the Allison 230 method might or might not access. (Note, in contrast, the present invention REQUIRES access of audio format periodically updated professional continuing education information). As the courses are not necessarily available over the network, repeated accessing of updated versions thereof over

said network is not obviated, and even accessing an identified course (as opposed to specifically audio format periodically updated professional continuing education information), once over the internet is not required by Allison 230. Neither does Allison describe updating the competency tests, which are what is directly accessed in Allison 230 and which Applicant feels best analogically correspond to the present invention audio format periodically updated professional continuing education information.

Importantly it is emphasized that the Allison 230 Patent is focused on providing direct access of Competency Tests to Health Care Professionals, to determine specific Professional Deficiencies. If a Health Care Professional passes an accessed Competency test no Courses are suggested to him or her, hence, the Health Care Professional is not made aware of Courses via the Allison methodology and therefore will not access such. (Note, the present invention provides audio format periodically updated professional continuing education without regard to any intermediate step test results). Continuing, if a Deficiency is identified by the Allison Competency testing, a listing of Courses is made available to the Health Care Professional under the Allison Methodology, which Courses are prepared to provide information aimed at correcting the specifically identified deficiencies, and which might or might not be available over the internet. (Note, the Claims in the present invention require that the Audio Format professional continuing education information be accessed via the information provider internet web site, and not from other information providers as allowed under Allison 230). Under Allison, if a Health Care Provider then takes an identified Course to maintain Professional Competency Requirements, a Record of it can be added to a list of his or her Completed Courses and that serves to indicate the overcoming of a

detected Deficiency. Again, that emphasizes that nothing in Allison suggests that the Competency Test be deleted or that Courses should be periodically updated and reaccessed a number of times by the Client to keep him or her aware and informed of developments in a topical area. Further, while the Allison 230 Patent indicates that Courses can be available in various formats, nothing therein states that Audio Format courses are provided On-Line, particularly by the same provider of the competency test, or that said tests are updated periodically, and that in the absence of deficiency identifying Competency testing as a guide that a category of professional continuing education information should be accessed even once, (let alone a number of times by a Client, with the information in the course being updated at least once between at least two accessings thereof). The Allison 230 Patent is simply not directed to providing audio format professional continuing education which is prepared by an information provider to keep said client current, (aware and informed of developments), in a topical category selected and received by a Client in return for payment. The Allison 230 Patent is directed to providing Course information from any available source, (not necessarily On-line and from the provider of the test), to train a client to overcome a specific documented professional competency deficiency which is identified by a Competency test administered by the Allison Method.

In contrast, the present invention is characterized in that the information in said client identified and received audio format professional continuing education is prepared to keep said client aware and informed of developments in the topical category and thereby maintain professional currency therein, to the exclusion of being prepared to train said client to overcome a specific documented professional competency deficiency as is done in the Allison 230 method. The present invention Claims 1, 12

and 19 therefore exclude practice of the very focus of the Allison 230 Patent. Further, step e in present Claim 1, for example, requires:

said information provider updating the audio format professional continuing education information in the at least one client identified topical category of interest in step d, and said at least one paying client in step d repeating step d after said audio format professional continuing education information is updated, and receiving the updated audio format professional continuing education information in said identified topical category of interest;

As the Examiner states on Page 5, Lines 3-4 of the Action, this step is NOT practiced in Allison.

As regards the Lawcast materials---they do describe providing information which is similar to that provided by the present invention method, however, the Lawcast materials do not recite distribution over the internet. I am very familiar with Lawcast as disclosed in Page 6 of the present Original Application. But Lawcast has always distributed tapes and CD's by mail. About a year ago they did send out a questionnaire re: would internet distribution be of interest, but to my knowledge they have not ever done so, or even considered it until about a year ago. As regards Lawcast, it is not argued that audio professional update services have not been known. In fact, do note that I tried to find funding to do very much the same as what Lawcast does, starting in 1984. I knew of PRN, (a medical FM Subcarrier distributed service), back then and thought it should be expanded to law even before 1984. The Provisionals from which the present Application Claims Benefit were basically that Prospectus with Internet replacing FM Subcarrier. Had I

only got it filed a few months earlier, before Allison, eh? And if I'd not been so busy back then I would have! I did conceive the idea at least a few months prior to the earliest priority date of Allison, (which is December 31, 1999). Again, I was very busy back then, however, and it took a while to modify the preexisting Prospectus and get it submitted as the Provisional. I have no readily available proof of my conception date of distributing periodically updated audio format professional information via the internet, but can state with certainty that it was well before December 31, 1999. (Note---the major difference in what I wanted to do in 1984 as described in the Prospectus which modified became the Provisional, as compared to what Lawcast started doing in about 1993 was that I wanted to use FM Subcarriers or perhaps direct satellite to ground to distribute the information). The basic idea for what Lawcast does, except for their approach to distribution, was available in the prospectus I, and my associates, prepared a decade before the Lawcast materials cited. But no disclosure of which I am aware, prior to my Provisionals in 2000, disclosed use of internet distribution of audio format periodically updated professional continuing education. I first conceived internet distribution of such information when becoming aware of music distribution over the internet.

I will add that Lawcast does a good job and I have subscribed to it since about 1993---but they were not the first to try to do such a service---they simply had access to funding. (Note---If I obtain this Patent it is my plan to contact Lawcast and offer a license).

Turning now to the specific points raised by the Examiner in his Action, as regards Claims 1-7, 9, 15 and 21 the Examiner argues that:

"Allison teaches a system and method of providing continuing education and learning assessment via an internet web site, (see at least abstract, Fig. 1, col. 1 line 5 through col. 2 lines 42", (emphasis added)).

Applicant responds by clarifying that the word AND is present between continuing education and learning assessment. The present invention does not require learning assessment as a pre-requisite to identifying continuing education to be received by a subscriber. Further, careful reading of Allison col. 1 line 5 through col. 2 lines 42" makes clear that the online education referred to therein are "courses", (see Col. 1, Lines 43-44), (as opposed to periodically updated categorized information as in the present Application), and then Allison 230 immediately makes clear that none of the courses provides an initial assessment of a health care professional's skills nor keeps track of those skills or training. Addition of that testing is what Allison 230 taught! This is in contrast to the present invention which has no requirement that an initial assessment be conducted, and nothing in Allison remotely suggests that said step be eliminated as it is the focal point of the Allison 230 method.

The Examiner also recites that Allison teaches:

an information provider providing an internet web site;

said information provider making audio format professional continuing education available from audio information machine readable storage via said web site, in topical categories;

making access to said audio format professional continuing



education information available, via said web site to clients by a selection from the group consisting of: periodic subscriptions, direct payment per access event; access gained on subscription basis, pay-per-use, one time fee;

said information provider allowing at least one client to receive said audio format professional continuing education via said web site by, using an internet accessing means, accessing said web site, and providing payment via a selection from the group consisting of: proof of paid subscription; and presenting payment means;

and identifying a professional continuing education information topical category of interest, followed by said at least one paying client receiving audio format professional continuing education information in said topical category of interest;

The Examiner recites additional points but then acknowledges that:

"Allison does NOT disclose updating the audio format in the at least one client identified topical category", (see page 5 lines 3-4 of the Action, and identifies and applies the Lawcast materials cited by the Examiner to provide that missing element of the present invention.

Applicant responds by pointing out that what Allison 230 teaches is the direct accessing of Competency Tests, (and only after a test identifies a deficiency does it suggest, not require, accessing training courses). Again, nothing in Allison 230 suggests that accessing of said Competency Tests should be deleted and that audio format periodically updated professional

continuing education be directly provided to clients. It is not understood how the Lawcast materials can be read to provide deletion of the requirement of testing in the Allison 230 teachings. Further, Allison 230 suggests courses, (not periodically updated audio format professional continuing education), to those accessing its system, and as the Examiner agrees, Allison does not suggest that said courses should be updated and re-accessed periodically. This is particularly true as regards specifying "audio format" courses. The purpose of the Allison 230 method is to provide internet accessible means which assess deficiencies in medical professionals accessing said assessment means, and Allison suggests courses which a professional can then access to overcome said identified deficiencies. The present invention specifically excludes coverage of the testing backbone basis of the Allison method. See that last paragraph in Presently Pending Claim 1, which states:

said method being further characterized in that the information in said client identified and received audio format professional continuing education is prepared to keep said client aware and informed of developments in the topical category and thereby maintain professional currency therein, to the exclusion of being prepared to train said client to overcome a specific documented professional competency deficiency. (emphasis added).

The Allison 230 teachings and the Independent Claims in the Present Application Claim 1, 12, 19 are thus seen to be mutually exclusive! It is noted that Presently Pending Independent Claim 23 does not include such language, but said Claim 23, as Amended herein, is distinguished over Allison as it provides access to periodically updated audio format professional continuing

education those using the present invention methodology, and said access must be performed, at least twice, once before and once after information in said topical category is updated. It is not argued that the Lawcast materials do not disclose the element of providing periodically updated information via mailed tapes or CD's as the delivery means, just as my earlier Prospectus disclosed delivery via FM Subcarrier or direct satellite to ground. However, nothing in the Lawcast materials suggests that said delivery means should be the internet. The earliest disclosure of that was in my provisional Applications.

As disclosed above, Lawcast has relatively recently, (about a year ago), begun to consider distribution via the internet. The present Application priority however, predates that by many years.

In conclusion, it is possible that the various elements of the present invention are found, in modified form, in the combination of Allison 230 and the Lawcast materials, but there are no teachings in a single reference that lead one skilled in the art to arrive at the present invention, except for the Original Application, and that can not be used under Graham vs. John Deere Co. To simply identify a plurality of references which variously contain elements of a new invention, without one of said references providing at least suggestions as how to modify the invention therein, to arrive at a new invention, is evidence that the Examiner used the Application as a teaching reference, and as such constitutes use of prohibited hindsight. In the present case the Examiner has identified elements in two references which if selected, while rejecting other elements therein, and then modified and combined properly might add up to the present invention. But it appears that the only way the Examiner knew to identify the references is that the Application

disclosed elements necessary. That is, Allison 230 as the basic reference does not teach or suggest how to identify the Lawcast materials, and then how to select certain elements in the somehow identified references, while rejecting others therein which are even more focal to the Allison 230 invention, and then how to modify said selected elements and combine them to arrive at the present invention. The only place said instructions are found in the present Application, and its use as a teaching reference is not allowed as a proper approach to determining Section 103 obviousness. Were such an approach to examination allowed, essentially no invention would ever be found Patentable.

### ATTESTATION

This is to attest that I conceived the idea of:

distributing, via the internet, as opposed to FM Subcarrier or direct satellite to ground or sending tapes or cd's via mail, audio format periodically updated professional continuing education to clients for payment, to keep clients aware and informed of developments in at least one topical category, as Claimed in the present Application No. Serial No. 10/796,162, which is a CIP of Serial No. 09/685,044 Filed 04/17/2000 and which therevia Claims Benefit of provisionals 60/198,157 Filed 04/17/2000 and 60/201,000 Filed 05/01/2000;

before the earliest priority date, (December 31, 1999), of a Patent to Allison No. 6,546,230. I had become aware of audio being transmitted over the internet in late 1999, (ie. music), and had been thinking about using that capability in distributing professional update information over the internet for at least a month prior to the Allison priority date. I disclose, however, that I was very busy back in late 1999 and early 2000 and as a result it took me a while to proceed.

While I do not have absolute proof of the above, I do have record of a Client (DE) contacting me by phone on January 27, 2000 regarding a Business Patent Method Patent. When I met with him shortly thereafter in my capacity as Patent Attorney, he disclosed his idea to me, and I told him about my idea as a via to explaining how Business method Patents had to be structured. I had been thinking about that for a few months and it seemed a reasonable approach to me to use my example to advise him at the time. Although the Patent Search on his idea stopped him from

proceeding, I think he would remember my telling him about my idea of providing a legal audio update service with internet distribution. I have not contacted him recently, although years ago I did contact him to see if he remembered my mentioning my idea to him. I think he still would remember that.

In late 1999 and early 2000 I had it in mind to write an Application for my idea, but time was just too tight. In about March of 2000 it occurred to me that I could modify a Business Plan Prospectus, that disclosed distributing legal update information over FM Subcarriers and perhaps Direct Satellite to Ground, which I had written with associates years prior, (first version in about 1984 with modifications over a period as late as in 1992), to constitute a Provisional. That is what I did in late March and early April of 2000 by replacing the terminology "FM Subcarrier", with "Internet", and it was given a Number 60/198,157 Filed 04/17/2000. I followed that up with Number 60/201,000 Filed 05/01/2000 and on 10/10/2000 submitted the Parent Application to the Present Application, which was given the Serial No. 09/685,044.

Again, I realize the foregoing is not absolute proof that I had the idea for what is Claimed in Application No. 10/796,162 which is presently under Examination, but I attest to the fact that what I am saying is true. Further, I believe that I was diligent in constructive reduction to practice after I conceived the idea in late 1999.

In conclusion, it is believed that the Allison 230 Patent should be removed as a reference against the present Application as having been sworn behind. I had the idea for what is Claimed in Application 10/796,162 prior to the earliest Allison 230 Patent priority date and was diligent in constructive reduction to practice in the form of submitting Provisionals 60/198,157 Filed 04/17/2000 and 60/201,000 Filed 05/01/2000, and Parent Utility Application No. 09/685,044 on 10/10/2000.



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In that my time is tight right now, the Specification has not yet been corrected for typos. Applicant respectfully requests the Examiner's permission to tend thereto once Claims are Allowed.

It is believed, that in view of the Discussion and/or the attached Attestation, that Claims 1 - 24, as Amended, are now Allowable. Therefore the Examiner is respectfully requested to provide the Notice of Allowance and Issue Fee Due. Should problems remain, Applicant welcomes suggestion from the Examiner.

Sincerely,



JAMES D. WELCH

JW/hs

enc. Rule 132 disclosure.





ATTESTATION

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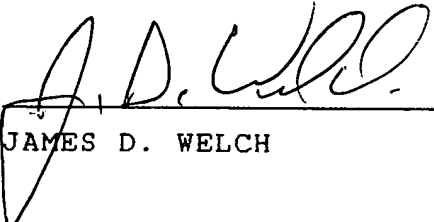
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I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further these statements were made with the knowledge that willful and false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 Title 18 of the United States Code, and that such wilful statements may jeopardize the validity of the application or any patent issuing thereon.

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JAMES D. WELCH                      DATE